REMARKS

Applicant has now had an opportunity to carefully consider the Examiner's comments set forth in the Office Action of March 7, 2005.

Reconsideration of the Application is requested.

The Office Action

Claims 1-7 and 13-15 currently remain in this application. Claims 8 and 9 are being canceled, as per the present paper, without prejudice or disclaim of the subject matter contained therein, and claims 10-12 had been previously canceled.

Claims 1, 13 and 15 have been allowed.

Claims 2-7 and 14 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Costanza, et al. (US 5,900,901) in view of Lin, et al. (US 5,659,399).

Comments/Arguments

The rejection of claims 2-7, 9 and 14 based upon the combination of Costanza and Lin is traversed.

The rejection fails to state a *prima facie* case for obviousness insomuch as there is no proper motivation recited to support the conclusion of obviousness. Significantly, the Examiner bears the initial burden of proving obviousness. See, MPEP §2142. As is well accepted, establishing a *prima facie* case of obviousness includes reciting a proper motivation for combining references. The Examiner has not done so in this instance. Rather, all the Examiner has established, if anything, is that the references are analogous art. While being analogous art is a requirement for applying references under 35 U.S.C. §103 (see, e.g., MPEP §2141.01(a)), in and of itself, simply being analogous art is far from sufficient for the establishment of *prima facie* obviousness. Note, the Office Action merely states that Costanza and Lin are "in the same field of endeavor," and in conclusory fashion, that "it would have been obvious ... to parse an image in the system of Costanza as evidenced by Lin." See, e.g., the top of page 4.

The MPEP is instructive as to this point. Per MPEP §2143.01, "Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge

generally available to one of ordinary skill in the art. In re Fine, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); In re Jones, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992)." In the present case, the Applicant has found no teachings, suggestions or motivation to combine in the references themselves. If the Examiner should contend otherwise, Applicant respectfully requests that the Examiner explicitly cite the column and line numbers where such teachings, suggestions or motivation may be found.

Additionally, the mere apparent ability to make a given combination does not provide sufficient motivation for making that combination. Again, as noted in MPEP §2143.01, "The mere fact that references **can be** combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. In re Mills, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990)." [Emphasis added]. That is to say, *prima facie* obviousness is not sufficiently established by the fact that references **can be** combined or modified. **The question that must be answered is why would one desire to make the combination or modification.** The Examiner provides no motivation that answers this question. In fact, the Examiner's only allegation is that the references **"can be"** combined. This is directly contrary to the accepted practices and the well established law regarding the sufficiency of motivation for combining references under 35 U.S.C. §103. Simply because two references are in the same field of endeavor, it does not necessarily mean one of ordinary skill in the art would want to combine them.

Furthermore, according to MPEP §2143.01, the "fact that the claimed invention is within the capabilities of one of ordinary skill in the art is not sufficient by itself to establish *prima facie* obviousness." Merely because claimed elements are individually found in the prior art, it does not necessarily follow that it would be obvious to combine the elements from different prior art references. See, MPEP §2143.01 citing Ex parte Levengood, 28 USPQ2d 1300 (Bd. Pat. App. & Inter. 1993). Consequently, absent a motivation to combine or modify the references, it is irrelevant that the elements and/or limitations may be individually or separately taught in the prior art.

Moreover, with specific reference to claim 2, contrary to the Examiner's assertion, Lin does not teach "parsing the plurality of input pixels for a determined image characteristic, said determined image characteristic including one of a boundary or a corner." The Examiner has alleged that this claimed feature is taught

by FIGURE 6 of Lin showing P1 and P5, which the Examiner takes as corresponding to a corner or boundary characteristics. However, this interpretation of Lin is clearly erroneous. FIGURE 6 does not correspond to any particular array of pixels as the Examiner apparently believes. Rather, FIGURE 6 shows a 1x5 context **window** that is used to selected a set of pixels over which the window is placed such that corresponding values for those pixels maybe processed together. See, e.g., column 5, lines 20 and 21, and column 8, lines 25-56. While Lin is arguably looking for a particular characteristic in the windowed pixels, nowhere is it suggested that this characteristic is a corner or boundary. Simply because the window itself has a corner or boundary (e.g., P1 or P5), that does not mean it is being used to detect a corner or boundary characteristic in the pixels over which it is placed. On the contrary, the characteristic Lin seeks is "the presence of image regions requiring compact dot growth control." See, e.g., the Abstract, lines 1-3. Applicants, can find nowhere in Lin where Lin suggests using the window shown in FIGURE 6 to find a corner or boundary characteristic in input pixels.

Clearly, P1 and P5 are not "boundary or corner characteristics" as the Examiner claims to interpret them. In fact, these elements are not even a part of an image or input pixels. Rather, as expressly taught by Lin, these elements are merely ends of a 1x5 window used to sample input pixel values.

Likewise, Costanza also fails to teach the foregoing parsing as claimed in claim 2. The Examiner concedes as much in the first sentence of the last paragraph on page 3 of the outstanding Office Action. Accordingly, insomuch as neither Lin nor Costanza explicitly teach or fairly suggest the claimed parsing, neither individually nor in combination, then claim 2 distinguishes patentably over the art, along with claims 3-7 depending therefrom.

Similarly, claim 14 calls for "parsing an input data sequence representative of [a] digital image until a determined condition is encountered, where the determined condition includes a corner." Again, neither Costanza nor Lin disclose this feature. That is to say, neither reference teaches detecting a corner condition within a digital image. Accordingly, the claim 14 distinguishes patentably over the art

CONCLUSION

For the reasons detailed above, it is submitted that all the claims remaining in the application are now in condition for allowance. The foregoing comments do not require unnecessary additional search or examination.

In the event the Examiner considers personal contact advantageous to the disposition of this case, he/she is hereby authorized to call John P. Cornely, at Telephone Number (216) 861-5582.

Respectfully submitted,

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